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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/372,416	08/11/1999	JONATHAN DORFMAN	EWG-087	1373

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BEH Investments LLC
1652 48th Street
Brooklyn, NY 11204

EXAMINER

HUYNH, THU V

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/372,416	Applicant(s) DORFMAN, JONATHAN	
	Examiner Thu V. Huynh	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed on 02/22/06 to application filed on 08/11/1999.
2. Claims 1-17 are canceled. Claim 18 is added.
3. Claim 18 is pending in the case.
4. Rejections in the previous office action have been withdrawn as necessitated by the amendment.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

Burman et al., US 2001/0010059 A1, filed 10/1998, in view of Wodarz et al., US 5,999,912, filed 05/97 and Davis et al., US 6,269,361 B1, filed 05/99.

Regarding independent claim 1, Burman teaches the steps of:

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- parsing the web page at a browser, wherein the web page includes a macro tag, wherein the macro tag includes a reference to a file, and wherein the file includes a reference to an advertisement server and JavaScript commands representing a request for the advertisement from the advertisement server (Burman, [0047]-[0062], [0066]; parsing a web page at a web browser, wherein the web page includes a macro tag. The macro tag includes a reference to a JavaScript file, wherein the JavaScript includes a reference to an advertisement server and JavaScript commands to request advertisement from the advertisement server);
- receiving at the advertisement server an indication of the request (Burman, [0062]; ad selection server 32 receives rich media request generated by user's browser);
- selecting at the advertisement server the advertisement from among a plurality of advertisements, wherein the selection is based on performance characteristics or configuration of user's computer in real time to fulfill the request (Burman, [0080], [0146]; "ad selection server deciding which ad or content to be served to the user"); and
- sending the advertisement to the browser, the browser superimposing the advertisement onto the web page (Burman, [0062], [0066]; ad selection server 32 sends the selected advertisement/banner/image to the user's browser for displaying on the web page).

However, Burman does not explicitly disclose the macro tag includes an identifier of the web page and selecting an advertisement based on the identifier of the web page and on competitive bidding among advertisers bidding in real time.

Wodarz teaches a macro tag includes an identifier of the web page and an advertisement is selected based on the identifier of the web page (Wodarz, col.2, line 60 – col.3, line 2; col.3, lines 49-55; col.4, lines 16-20; embedding an ad tag in a web page, wherein the ad tag includes the location or page identifier which is used to select an advertisement; “generates a list of ads matching the ad type and location information (i.e., page identifier) of the ad tag”).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Wodarz’s teaching and Burman’s teaching to include the page identifier in the macro tag, since the combination would have provided advertisement/banner/image based on user’s configuration and/or the page identifier as Wodarz disclosed.

Davis teaches advertisement is selected based on competitive bidding in real time to fulfill a request (Davis, col.5, lines 62-65; col.18, line 37 – col.19, line 7; competitive bidding among advertisers is used to decide advertisements in the search result list).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Davis’s advertisers bidding into Burman and Wodarz’s teaching, since the combination would have provided advertisement/banner/image based on user’s configuration, page identifier and/or competitive bidding among advertisers.

Response to Arguments

8. Applicant's arguments with respect to claim 18 have been considered but are moot in view of the new ground(s) of rejection.

Applicants point out that “neither the real-time bidding feature, nor the “macro tag” with an identifier of the web page, are describe in Burman”.

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However, the combination of Burman, Wordarz and Davis teaches such features as explained in the rejection above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Herz et al., US 5,835,087, filed 10/95, teaches system for generation of object profiles for a system for customized electronic identification of desirable objects.

Dedrick, US 5,724,521, filed 11/94, teaches method for providing electronic advertisements to end users in consumer best-fit pricing manner.

Angles et al., US 5,933,811, filed 08/96, teaches method for delivering customized advertisements within interactive communication system.

Goldhaber et al., US 5,794,210, filed 12/95, teaches attention brokerage.

Eldering, US 6,324,519 B1, filed 03/99, teaches advertisement auction system.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is (571) 272-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TVH
May 11, 2006



STEPHEN HONG
SUPERVISORY PATENT EXAMINER